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In re Patent Application of:

Andrey A. BOUKHAROV, *et al.*

Appl. No.: 09/702,134

Filed: October 31, 2000

For: Plant Genome Sequence and Uses  
Thereof

Art Unit: 1634

Examiner: D. JOHANNSEN

Atty. Docket: 16517.114

### Response to Election Requirement

Commissioner for Patents  
Washington, D.C. 20231

Sir:

In response to the Office Action mailed July 2, 2002 (Paper Number 5), Applicants submit the following response.

#### Remarks

In the Office Action mailed July 2, 2002, the Examiner required election under 35 U.S.C. § 121 to either a single SEQ ID NO or to nucleic acids encoding a single protein selected from Table 1. Applicants respectfully traverse the election requirement, and provisionally elect SEQ ID NO: 7212 for further prosecution.

Applicants note that the Examiner also states that upon election of a SEQ ID NO, "Applicants should further identify the protein of Table 1, if any, that corresponds to the elected invention." Office Action at page 2. Applicants respectfully draw the Examiner's attention to the fact that claims 1 through 4 are directed to a nucleic acid molecule having a nucleic acid sequence selected from the group consisting of SEQ ID NO: 1 through SEQ ID NO: 52202 or complements thereof. Claims 5 through 7 are directed to a nucleic acid molecule encoding a protein or fragment thereof selected from the group consisting of a rice protein or fragment thereof from Table 1. Applicants draw the Examiner's attention, with respect to claims 5

through 7, to the fact that in Table 1, SEQ ID NO: 7212 corresponds to a probable gibberellin C-20 oxidase. See Table 1, SEQ ID NO: 7212, molecule corresponding to a gene from *Oryza sativa*.

The Examiner asserts that the “molecules encompassed by the instant claims are patentably distinct by virtue of having different structures and encoding proteins having different functions.” Office Action mailed July 2, 2002, at page 2. However, Applicants submit that election of a single nucleotide sequence is improper and Applicants believe no serious burden would result by the search and examination of at least ten nucleotide sequences. The election of a single nucleic acid sequence contravenes the USPTO policy as set forth in the Manual of Patent Examining Procedure stating that “to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided ... to permit a reasonable number of such nucleotide sequences to be claimed in a single application.” (MPEP, 8<sup>th</sup> ed., August 2001, Section 803.04). The MPEP further provides that “[i]t has been determined that normally ten sequences constitute a reasonable number for examination purposes.” (emphasis added) *Id.* While the Examiner requires that a single nucleotide sequence be selected, no reason has been provided for this deviation from articulated Patent Office policy.

Based upon the foregoing, Applicants submit that the election requirement is improper and therefore must be withdrawn. To facilitate prosecution, however, Applicants have provisionally elected, with traverse, SEQ ID NO: 7212.

In view of the above, each of the presently pending claims is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding election requirement and to pass this application to issue. Should the Examiner have any questions regarding this application, the Examiner is encouraged to contact Applicants' undersigned representative at (202) 942-5000.

In the event that extensions of time beyond those petitioned for herewith are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned. Applicants do not believe any additional fees are due in conjunction with this filing. However, if any fees under 37 C.F.R. 1.16 or 1.17 are required in the present application, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter Deposit Account No. 50-2387, referencing matter number 16517.114.

Respectfully submitted,



David R. Marsh (Reg. No. 41,408)

Holly Logue Prutz (Reg. No. 47,755)

DATE: October 2, 2002

ARNOLD & PORTER  
555 Twelfth Street, N.W.  
Washington, DC 20004  
(202) 942-5000 (telephone)  
(202) 942-5999 (facsimile)